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Patent Application
Attorney Docket No. GEMS8081.072**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of : Zettel et al.
Serial No. : 09/681,573
Filing Date : May 1, 2001
For : Method and System for Publishing Electronic Media to
A Document Management System in Various
Publishing Formats Independent of the Media Creation
Application
Group Art No. : 2178
Examiner : Stork, K.

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. The request is being filed with a Notice of Appeal. The review is requested for the reasons set forth hereinafter.

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REMARKS

Claims 1-29 are pending in the present application. In the Final Office Action mailed October 07, 2005, the Examiner rejected claims 1-11, 13-25, 35, 27, and 29 under 35 U.S.C. §103(a) as being unpatentable over Academic Technology Services (ATS) and further in view of Bendik (US Pub No. 2002/0002563). The Examiner next rejected claim 12 and 16-23 under 35 U.S.C. §130(a) as being unpatentable over ATS and Bendik and further in view of Alam et al. (USP 6,336,124). Claim 24 is rejected under 35 U.S.C. §103(a) as being unpatentable over ATS, Bendik, and Alam and further in view of Ouchi (USP 6,370,567). Claim 26 remains rejected under 35 U.S.C. §103(a) as being unpatentable over ATS and Bendik and further in view of Chent et al. (USP 6,009,442). Claim 28 remains rejected under 35 U.S.C. §103(a) as being unpatentable over ATS and Bendik in view of Ouchi.

With respect to claim 1, the Examiner concluded that ATS teaches “[s]electing a publication format via the publication enabler (pages 23-24).” *Office Action, Oct. 7, 2005, p. 3*. The Examiner further stated that “[i]n addition to specifying several formatting options within a publication (page 6, number 4; page 12, Figures 12-14), which could be considered to be selecting a publication format, ATS also discloses selecting the publication format as a PDF document or an interactive PDF form (pages 23-24).” *Id. at 16*.

Pages 23-24 of ATS disclose an appendix entitled “PDF Forms on the Web.” *Page 23*. The appendix briefly describes what a PDF form is, fields available for use on the PDF form for gathering information, and differences between HTML and PDF forms. *Id. at pp. 23-24*. This section of ATS fails to teach or disclose creation of a form-fillable PDF document. While the appendix may briefly describe features and/or benefits of a PDF form, ATS fails to disclose how a PDF form is created. That is, ATS does not teach that Adobe PDFWriter may create a PDF form. Claim 1 calls for, in part, initializing a publication enabler capable of converting a data file into at least one publication format in response to the publication instruction. As stated above, claim 1 further calls for selecting a publication format via the publication enabler. The publication enabler identified by the Examiner in ATS is the Adobe PDFWriter, but it does not make any publication format choice available to a user for selection thereof. That is, the Adobe PDFWriter of ATS only creates files of one format, i.e. PDF. While the Examiner concluded that that taught in the appendix of ATS indicates that the publication enabler allows selection of

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a publication format, one skilled in the art would recognize that the form PDF as described in the appendix of ATS is not created by the Adobe PDFWriter as described in pages 3-5 of ATS. Accordingly, since the elements of claim 1 are wholly absent from the references, this Request is properly decided by the Panel in favor of Applicant.

With respect to claim 8, the Examiner stated that "claim 8 is similarly rejected under ATS and Bendik." Applicant disagrees that claim 8 merely executes the method of claim 1 as suggested by the Examiner. Further, the rejection of claim 1 fails to indicate where the prior art teaches the act of publishing the content of the electronic media directly into the at least one publication format in accordance with the received media control instruction and storage rules of the document management system as called for in claim 8. The Examiner stated that Bendik discloses a document management system with storage criteria. However, the Examiner's statement fails to show that the prior art teaches publishing the content of the electronic media in accordance with storage rules of the document management system. ATS fails to disclose publishing PDF documents in accordance with any storage rules of any system. Further, one skilled in the art would readily recognize that publishing documents from the Adobe PDFWriter as taught in ATS in accordance with storage rules of a document management system would require modifications to the Adobe PDFWriter not suggested or taught in any of the prior art of record. Accordingly, since the elements of claim 8 are wholly absent from the references, this Request is properly decided by the Panel in favor of Applicant.

With respect to claim 16, the Examiner stated that ATS teaches "converting data directly from one format into a publication format (page 3, number 1 – page 5, number 7)." *Office Action, supra at 11*. The Examiner further stated that ATS teaches "transmit[ting] the converted data to at least one publication system capable of publishing the data file into a publication format (page 5, number 7)." *Id.* Claim 16, however, calls for, in part, routing an electronic data file to a converter configured to convert an electronic data file directly into at least one of a number of publication formats compatible with a document management system. Claim 16 further calls for transmitting the at least one converted data file to at least one publication system capable of publishing the converted data file in the at least one publication format to the document management system. ATS merely teaches using Adobe PDFWriter to generate a PDF from a print dialog. *See pp. 3-5*. ATS, however, does not teach or suggest a converter

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configured to convert the electronic data file and at least one publication system capable of publishing the converted data file as called for in claim 16. At best, the Adobe PDFWriter generates a PDF document, but ATS fails to disclose a converter together with at least one publication system.

The Examiner stated that "Bendik discloses a document management system." *Id.* However, Bendik fails to teach a converter configured to convert the electronic data file or at least one publication system capable of publishing the converted data file.

The Examiner further stated that Alam discloses "rout[ing] the electronic data file to a converter configured to substantially simultaneously convert the electronic data file into at least two of a number of publication formats." *Id.* Notwithstanding that claim 16 does not call for a converter configured to substantially simultaneously convert the electronic data file into at least two of a number of publication formats, Alam also fails to teach or suggest a converter configured to convert the electronic data file and at least one publication system capable of publishing the converted data file all as called for in claim 16. Accordingly, since the elements of claim 1 are wholly absent from the references, this Request is properly decided by the Panel in favor of Applicant.

With respect to claim 25, the Examiner stated that ATS discloses "[a] processing unit programmed to call the GUI on demand and enable a user selection of one or more publication formats, wherein the one or more publication formats including (sic) publication formats non-native to a creation document (pages 4-5, numbers 3-6)." *Office Action, supra at 8.* The Examiner further stated that "ATS fails to specifically disclose conforming to a document management system with parameters. However, Bendik discloses conforming data to a document management system with parameters (paragraph 0049)." *Id.*

The Specification defines "format". The Specification discloses:

Further, a format selector or drill down menu 110 is provided that allows the user to select a document format for which the electronic document should be published in to the document management system. That is, the present invention allows the user to select for publication a document format 110 that is foreign to the format in which the electronic document was created. That is, the present invention allows the user to change the format of the electronic document from the default format to another more desired format. For example, the user may elect that the electronic data file be published to the document management

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system as a text file (.txt), a rich text format (.rtf), or a DjVu (.djvu) format rather than the default document file (.doc).

Paragraph 0033.

The Examiner's ATS reference is directed to Adobe PDF, which is an acronym for "Portable Document Format." One skilled in the art would recognize that "format" is not directed to parameters, as suggested by the Examiner, but rather to the file type. ATS fails to disclose enabling a user to select any publication format. That is, ATS teaches an Adobe PDFWriter for creating PDF documents that only has one publication format, i.e. PDF. The Adobe PDFWriter does not enable user selection of any publication format. The Examiner has provided no reference that supports a system that allows the creation of documents in publication "formats" that conform to document managements system parameters, wherein a user is allowed to select from one of those formats. Accordingly, since the elements of claim 1 are wholly absent from the references, this Request is properly decided by the Panel in favor of Applicant.

The Panel has jurisdiction since this review is not limited to interpretation of the references because the references are wholly lacking in terms of disclosing or suggesting the elements of the claims. Elements are wholly absent.

In light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests favorable consideration of all pending claims in a pre-appeal conference review.

Respectfully submitted,



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